

REMARKS

Applicants have carefully considered the March 22, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 10-12 and 16-20 are pending in this application. Claim 20 has been amended to merely change its dependency to claim 11 and claim 16 has been amended in accordance with the Examiner's suggestion. Support for the amendment is found in the originally filed specification and claims. Applicants submit that by the present Amendment and Remarks, this application is placed in clear condition for immediate allowance. At the least, the present amendments reduce the number of issues, thereby placing this application in better condition for Appeal. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are respectfully solicited pursuant to the provisions of 37 C.F.R. § 1.116.

Initially, Applicants note that claim 19 was identified by the Examiner as pending and rejected in the disposition of claims on PTO form 326, however, there were no rejections or objections of this claim in the body of the Office action.

Claim 20 was rejected under 35 U.S.C. § 112, second paragraph. Applicants have amended claims 20 to provide antecedent basis for the silicon oxide liner and silicon nitride liner. The dependency of claim 20 has been amended to depend from claim 11. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of claim 20.

Claim 16 was objected to for a minor informality. Applicants have amended claim 16 in accordance with the Examiner's suggestion. Accordingly, the Examiner is requested to reconsider and withdraw the objection of claim 16.

Claims 10-12 were rejected under 35 U.S.C. § 102(e) as being anticipated over Ngo et al. (U.S. Pat. No. 6,521,529, hereinafter “Ngo”). Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the method disclosed by Ngo that would preclude the factual determination that Ngo identically describes the claimed invention within the meaning of 35 U.S.C. § 102.

Claim 10, recites *inter alia*, that a nitride liner is deposited on the oxide liner and that a sidewall spacer is formed on the nitride liner. In contrast, Ngo fails to identically disclose or suggest the claimed method. Rather, as disclosed at col. 4, lines 42-57, subsequent to forming the silicon oxide liner 23, silicon nitride sidewall spacers 24 are formed by depositing a conformal layer. Thereafter, as disclosed at col. 5, lines 47-51, an insulating surface layer 40 is formed on the silicon nitride sidewall spacers 24. The Examiner misidentified the insulating surface layer as “sidewall spacer 40”. Thus, contrary to the Examiner’s assertion, Ngo clearly discloses that insulating surface layer 40 is formed on the silicon nitride sidewall spacers 24 and

Ngo fails to disclose the step of forming a sidewall spacer on a nitride liner, as recited in claim 10. It is improper for the Examiner to ignore or re-characterize the explicit designation of the layers, or the order of their deposition, contrary to the teachings of the reference. Accordingly, Ngo fails to identically disclose each recited step of method claim 10 and, therefore, the rejection under 35 U.S.C. § 102(e) is not legally viable and should be withdrawn.

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Yu (U.S. Pat. No. 6,506,650, hereinafter “Yu”).

Claims 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Yu and further in view of Miles (U.S. Pat. No. 6,235,597, hereinafter “Miles”).

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ngo in view of Ramaswami (U.S. Pat. No. 5,783,475, hereinafter “Ramaswami”).

Applicants respectfully traverse each of the above rejections under 35 U.S.C. § 103(a). The prior art rejections under 35 U.S.C. § 103(a) are by way of 35 U.S.C. § 102(e) because Ngo was filed on October 5, 2000 and issued on February 18, 2003. The present application is a Divisional application of Serial No. 10/021,499, which was filed on December 19, 2001. Although Applicants disagree that the claimed invention is obvious predicated upon Ngo in view of any the above secondary and tertiary references, to expedite prosecution of the Application, Applicants submit that the reference to Ngo cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention or subject to an obligation of assignment to the same person.

The cover page of Ngo (U.S. Patent No. 6,521,529) indicates that the Patent was assigned to Advanced Micro Devices, Inc. of Sunnyvale, California. Under M.P.E.P. § 702.02(l), common ownership at the time the later invention was made can be evidenced by referring to an assignment which is recorded in the Patent and Trademark Office in accordance with 37 C.F.R. Part 3. The Assignment of Application No. 10/021,499 (the parent of the present Divisional application) to Advanced Micro Devices, Inc. of Sunnyvale, California was recorded in the U.S. Patent and Trademark Office and the Assignment appears at Reel 012395, Frame 0944.

Therefore, the subject matter disclosed by Ngo and Applicants' present claimed invention were subject to an obligation of assignment to the same person, i.e., Advanced Micro Devices, Inc., of Sunnyvale, California. As such, under 35 U.S.C. § 103(c), the reference to Ngo cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Furthermore, the remaining secondary and tertiary references, alone or in combination, fail to teach or fairly suggest every limitation of the claims. Accordingly, the rejections are not legally viable and the Examiner is requested to reconsider and withdraw the rejections of claims 16-18 and 20.

It is believed that pending claims 10-12 and 16-20 are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Brian K. Seidleck".

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